

FILED

DEC 1 1953

HAROLD B. WILLEY,

IN THE

Supreme Court of the United States

OCTOBER TERM, A. D. 1953.

No. 228

**EMANUEL L. MAZER AND WILLIAM ENDICTER,
DOING BUSINESS AS JUNE LAMP MANUFACTUR-
ING COMPANY,**

Petitioners,

vs.

**BENJAMIN STEIN AND RENA STEIN, DOING BUSI-
NESS AS REGLOR OF CALIFORNIA**

Respondents.

Reply Brief for Petitioners

MAX R. KRAUS,
33 N. LaSalle St.,
Chicago, Ill.

ROBERT L. KAHN,
105 W. Adams St.,
Chicago, Ill.

Counsel for Petitioners.

POOR COPY

BLEED THROUGH

TABLE OF CONTENTS

	PAGE
Existence of Design Patent Laws affects scope and interpretation of Copyright Laws relating to three dimensional works of art	1
Differentiation between Copyright and Design Patent monopolies along manufacturing lines is rational and sound and has a legal basis	3
Fundamental shift in policy of a Government Bureau can only be accomplished by new legislation	5
Monopolies must be created by law, not sympathy	6
Artistic articles of manufacture such as here copyrighted have long been protected by the Patent Office	9
Respondents' alleged copyrights invalid ab initio	10
The Expert case	11
Conclusion	12

CASES.

Bleistein v. Donaldson Co., 188 U.S. 239 (1903)	9
Blumer v. McQuewan, 14 Howard (55 U.S.) 539, 549, 14 L. Ed. 532	2
Fisher Music Co. v. Witmark, 318 U.S. 643 (1943)	3
Gorham v. White, 81 U.S. 511 (1871)	5
Stein v. Expert Lamp Co. (The Expert case)	11
Steinmetz v. Allen, 192 U.S. 543	6

UNITED STATES AND BRITISH COPYRIGHT ACTS.

1870 United States Copyright Act, Sec. 86	2
British Copyright Act of 1911	3
1883 United States Copyright Act	7

BOOKS.

Copinger and James—Law of Copyrights, 8th Ed. London, 1948	3
---	---

BLEED THROUGH

POOR COPY

IN THE

Supreme Court of the United States

OCTOBER TERM, A. D. 1953.

No. 228

EMANUEL L. MAZER AND WILLIAM ENDICTER,
DOING BUSINESS AS JUNE LAMP MANUFACTUR-
ING COMPANY,

Petitioners,

vs.

BENJAMIN STEIN AND RENA STEIN, DOING BUSI-
NESS AS REGLOR OF CALIFORNIA

Respondents.

Reply Brief for Petitioners

EXISTENCE OF DESIGN PATENT LAWS AFFECTS SCOPE
AND INTERPRETATION OF COPYRIGHT LAWS RELATING
TO THREE DIMENSIONAL WORKS OF ART.

Petitioners have previously asserted and demonstrated (Pet. Br. pp. 14-19) that the existence of the design patent laws makes it necessary to interpret the copyright laws **INSOFAR AS THREE DIMENSIONAL WORKS OF ART ONLY** are concerned in a manner to avoid duplication or overlap. Respondents (Res. Br. p. 26) content themselves with the assertion that "Neither refers to the

other." The Copyright Office does not meet this thesis squarely. It argues that the monopolies are different; it distorts the question presented to avoid the use of "manufacturer" (Copy. Br. p. 2) and purports to demolish petitioner's argument on mass production in a footnote (Copy. Br. p. 15) to the effect that mass production of books and paintings have never been condemned. The copyrighted contents of a book or the printed reproduction of a painting is not an article of manufacture.

The Consolidated Act of 1870 covering mechanical and design patents and copyrights did not explicitly define the rights and privileges of a patentee. However, this Court in *Blumer v. McQuewan*, 14 Howard (55 U.S.) 539, 549, 14 L. Ed. 532, said:

"The franchise which the patent grants, consists altogether in the right to exclude everyone from making, using, or vending the thing patented without the permission of the patentee. This is all that he obtains by the patent."

In the same 1870 Act, the copyright privileges in Section 86 were specified as:

"the sole liberty of printing, reprinting, publishing, completing, copying, executing, finishing and vending."

The rights granted under the design patent and copyright laws in force at present are identical with the rights specified above. The present copyright law grants sole rights (Section 1 (a) "To print, reprint, publish, copy and vend the copyrighted work" and (b), "to complete, execute and finish it if it be a model or design for a work of art."

The design patent and copyright sections of the 1870 Act both specified "statues." In the design patent portion, the "statute" protected was clearly an article of

manufacture. The copyright "statue" to be protected was a work of fine art.

The difference in the grants under design patent and copyright laws must be due to the manufacturing rights. The word "copy" in the copyright section of the 1870 law and in the present copyright law cannot possibly mean to manufacture in quantity.

DIFFERENTIATION BETWEEN COPYRIGHT AND DESIGN PATENT MONOPOLIES ALONG MANUFACTURING LINES IS RATIONAL AND SOUND AND HAS A LEGAL BASIS.

This Court in *Fisher Music Co. v. Witmark*, 318 U.S. 643 (1943) has clearly shown that the basic roots of copyright law go back to early British law. The recent development of British law on the matter in issue is instructive.

In England, the Copyright Act, 1911, (Copinger and James on the Law of Copyright, 8th ed. pub. London, 1948, pp. 388-413) grants the sole right (Sec. 2) to "produce or reproduce." In Sec. 22 of this British Act (p. 402), the law provides that it shall not apply to designs which may be registered under the Patent and Design Acts "except designs which, though capable of being so registered, are not used or intended to be used as models or patterns to be multiplied by any industrial process."

It is thus apparent that the British differentiate works of art for copyright and for protection under the Design Patent Act on the basis of mechanical reproduction. In fact, by an order of the Board of Trade dated in 1932, (Copinger, p. 429) it was decreed that 50 single articles was the limit of reproduction under copyright.

The copyright laws of the United States from 1870 up to date have not used the broad language of "produce" or "reproduce" but instead used "copy" in the grant. The use of this word "copy" is significant and explains why Sec. 22 of the British Act defining the line of demarcation between copyright and design patent along manufacturing lines was not considered to be necessary in the United States laws.

Up to 1948 (the year when the Copyright Office changed its policy on three dimensional works of art) the policy of the Copyright Office as indicated by its regulations in force for 40 years (Pet. Br. pp. 21-22) was to consider appropriate items submitted for registration as works of art, not articles of manufacture. The Copyright Office in its regulations from 1909 to 1948 specifically referred to the patent laws to put the public on notice that there was a line of demarcation between copyrights and design patents. In 1948 the Copyright Office changed its regulations in an attempt to obliterate the line of demarcation and omitted all reference to patent laws.

The Copyright Office prior to 1948 could not and did not attempt to guess what the intentions of a copyright registrant were. It simply took the word of each registrant that the item was a work of art as distinguished from an article of manufacture. Since 1948, the Copyright Office apparently does not care.

For example, the Copyright Office has photographs in its brief (App. C) to show a silver spoon, a letter opener, a magazine rack, a cabinet and a clock as being registered as works of fine art at the turn of the century. With renewals, the copyrights would still be in force. If the spoon, for example, were not mass produced, then it may be con-

sidered as a work of art. But if the spoon were mass produced (and the Copyright Office does not have the facilities for determining this) then the reasoning of this Court in *Gorham v. White* (81 U.S. 511 (1871)) on the design of a spoon as an article of manufacture is ignored.

It is submitted that around 1904 and even now, such copyright registrations as cited above in the photographs do not support quantity manufacturing monopolies.

Since 1948, the policy of the Copyright Office, as indicated by the new regulation (202.8, Pet. Br. Chart opp. p. 46) and the Warner article (Pet. Br. Appendix) has been changed in a fundamental manner. The change in the policy is not simply a redefinition of what is a work of art or fine art. It is an assertion that the Copyright Office offers cafeteria service, quickly, simply and cheaply to manufacturers who will not, dare not, or cannot go to the Patent Office.

**FUNDAMENTAL SHIFT IN POLICY OF A GOVERNMENT
BUREAU CAN ONLY BE ACCOMPLISHED
BY NEW LEGISLATION.**

The lack of statutory authority to copyright articles of manufacture, as the statues and lamps in suit here, can not be cured by any juggling of regulations of the Copyright Office. If, as the trial judge below (Rec. p. 58) found, the new regulation 202.8 is the same as the old regulation 12 (g) (both in Pet. Br. opp. p. 46) then we submit that the copyright registrations in suit are invalid because of non-compliance with the regulation and statute. If the new regulation is broader and is supposed to justify the copyrights in suit, then the regulation must fall, together with the copyrights, as not being in compliance with the copyright law. The Copyright Office brief (pp.

13-14) implying a concession by petitioner as to the registrability of lamps under the present copyright regulation 202.8 is therefore in error.

Both the respondents and the Copyright Office contend that the regulations of the Copyright Office in force from 1909 up to 1948 do not mean what they say but really define the extreme limits. All regulations define limits. In the case of *Steinmetz v. Allen*, 192 U.S. 543, this Court had occasion to consider one of the rules of practice of the United States Patent Office. On page 556, this Court pointed out

"the Commissioner of Patents, exercising ~~the~~ power conferred, established, among other rules of practice, Rule 41. It thereby became a rule of procedure and constituted, in part, the powers of the primary Examiner and Commissioner. In other words, it became an authority to those officers, and, necessarily, an authority 'under the United States.' "

It is submitted that the rules and regulations of the Copyright Office existing from 1909 up to 1948 became an authority to the register of Copyrights "under the United States." The Register was just as much bound by those regulations as was the general public. If the 1948 regulation 202.8 is not simply a redefinition but rather a fundamental reorientation of copyright policy, then we submit it can only be accomplished by and under new statutes by Congress.

**MONOPOLIES MUST BE CREATED BY LAW,
NOT SYMPATHY.**

The Respondents (Res. Br. pp. 27-29) imply that there is some inherent law of nature or justice that should protect a manufacturer of ornamental articles of manufacture

against copying; that if the design patent laws can not be satisfied then the copyright laws should apply. Natural law and justice are just as strong in England as here. There the law explicitly states that copyright cannot be used as an instrument of subversion of the design patent requirements. In the United States and in England there is no rule of natural law or justice which functions as a substitute for a mechanical patent. If an inventor can not satisfy the novelty requirements, his discovery is in the public domain and can be copied by anyone.

If an industrial designer can not satisfy the novelty requirements of the design patent laws, then his design **AS USED ON ARTICLES OF MANUFACTURE** can be copied by anyone. We submit again that a three dimensional artistic article of manufacture, such as the lamps or the statues here, can be protected only under design patent law.

The respondents and Copyright Office refer to a copyright law enacted in 1883 in support of their contention that manufacturers of artistic articles of manufacture are protected by copyright. This particular law was passed by Congress in response to demands for an amelioration of the requirements of the 1870 law regarding the copyright notice. For the first time, the 1883 law permitted the required copyright notice to be placed on some inconspicuous part of the work of art, such as the bottom or back. This same law did mention "manufacturers." If Congress had any intention at all to provide manufacturing rights for three dimensional works of art, it would have retained "manufacturer" in connection with three dimensional works of art. Only "copy" in the 1870 act was retained in the 1909 copyright law. **The 1909**

copyright law retained the copyright notice location feature of the repealed 1883 Act but discarded any reference to "manufacturers."

If the operation of design patent law works an injustice, fancied or real, then the remedy is up to Congress. Designs for dresses, methods of doing business are two fields where there is admittedly no protection. Congress has been importuned to remedy the dress design problem but Congress has refused. No one has successfully invoked natural law or justice to prevent style copying.

When the Patent Office refuses a patent on a design, it means that the design as far as articles of manufacture are concerned is in the public domain. Anyone can manufacture an article using such a design. A design in the public domain may be copyrighted—**BUT IF THE COPYRIGHT IS INTERPRETED TO MEAN MANUFACTURING RIGHTS** then what is the good of the holding that the design is in the public domain?

To validate the copyrights in suit for articles of manufacture on the ground that the Patent Office will not find patentable novelty in the "free forms" and other elements of art is to invite those rejected by the design division of the Patent Office, or those who feel that they will be rejected, to go to the Copyright Office. In other words, the Copyright Office would be encouraged to accept, for copyright, designs for articles of manufacture, which have been or would be held unpatentable and thus be in the public domain. If the copyright term were for several years or if there were safeguards to prevent subversion of design patent requirements, then there might be some sympathetic ground for the argument that respondents should have the benefit of some limited protection. But

when the copyright monopoly is created solely by the claimant, for a possible 56 years, with the drastic penalty provisions, then the instinct of self protection on the part of the public dictates rigid compliance with the law and no resolutions of doubts tending to subvert the design patent laws.

**ARTISTIC ARTICLES OF MANUFACTURE SUCH AS HERE
COPYRIGHTED HAVE LONG BEEN PROTECTED
BY THE PATENT OFFICE.**

The respondents and Copyright Office suggest that the Patent Office has and still does confine its field to non-artistic articles of manufacture, that the articles of manufacture contemplated by the design patent laws are not works of art, do not have "standard art form" or "free forms" or true sculpture. As the petitioners' book of exhibits of design patents shows, the Patent Office has and still does grant patents having the above artistic attributes. There are many examples of sculpture and other highly artistic articles of manufacture ranging from purely ornamental (figures and statues) to combined ornamental and utilitarian (lamp bases, clocks, book ends, plates).

Both the respondents and Copyright Office have relied heavily on *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239 (1903). This case shows that a copyrighted painting may be used for commercial purposes.

Petitioners are not arguing for a restriction of the nature of the use of a copyrighted item but are arguing against the abuse of the copyright monopoly in expanding "copy" of a work of art to mean mass produce an article of manufacture. It should be observed that painting is not an article of manufacture so that the present design patent law would have no bearing upon present copyright law as applied to painting.

The real lesson of this case lies in the setting off of work of art against an article of manufacture. As Justice Holmes stated in that case (p. 251)

"The antithesis to 'illustrations, or works connected with the fine arts' is not works of little merit or of humble degree, or illustrations addressed to the less educated classes; it is 'prints or labels designed to be used for any other articles of manufacture.' "

Paraphrasing the above, the antithesis to works of art or works of fine art is articles of manufacture.

As the respondents suggest, there is no reason why an artist or artistic person should not make money like anybody else. On the other hand, we respectfully suggest that simply because a person has artistic talent is no reason for considering such person other than an industrial designer and making it easier for such a person to make money. When an artist becomes a manufacturer or a designer for a manufacturer he is subject to the limitations of design patents and deserves no more consideration than any other manufacturer or designer.

RESPONDENTS' ALLEGED COPYRIGHTS INVALID AB INITIO.

The Copyright Office brief alleges that petitioners concede the validity of respondents' copyrights but argue misuse or non-infringement. Independently of the existence of the Design Patent Laws, respondents' alleged copyrights were destroyed by selling one thing and registering something else. In addition, the existence of the design patent laws negatives any compliance with the copyright law on the part of respondents.

We submit that a three dimensional product which is created by a manufacturer for practical utility and manufactured by mechanical means in mass production is neither a work of fine art nor a work of art as contemplated by the copyright law. Such manufacturer who sells or publicly distributes the manufactured product under copyright notice and who registers his alleged copyright by sending such manufactured product to the Copyright Office is not copyrighting a work of art but is attempting to copyright an article of manufacture and establish a monopoly, which if it can be established at all can only be effected by way of the design patent laws.

Again it should be observed that, unlike the patent monopoly which is brought into being by the Patent Office, the copyright monopoly is self created by publication or sale with notice, the duration being for 28 years with a possible renewal for another 28 years. The registration of the monopoly in the Copyright Office is a mere formality which the copyright proprietor can perform at any time convenient to him. The only requirement is that the registration be effected before suit on the copyright. The Copyright Office concedes this (Br. p. 39).

It is clear from the above that no statutory copyright ever came into being and the alleged copyrights in suit were and are invalid from the very beginning.

THE EXPERT CASE.

Respondents (Br. pp. 29-30) discuss the *Stein v. Expert* case in the District Court and Court of Appeals for the 7th Circuit. Respondents have seized upon some supposed differences over other Stein lawsuits to indulge in a hypothesis that but for such differences the District Court and

Court of Appeals in the 7th Circuit would have reached a different conclusion. Upon petition by Stein for reconsideration in the District Court in Chicago, the District Court in Chicago disposed of these differences as immaterial and denied the petition. (Def. Pet. physical ex. 1) The Court of Appeals for the 7th Circuit affirmed. The respondents in the Court of Appeals below expressly stated (page 32 of brief before Court of Appeals 4th Circuit)

"Stein v. Expert Lamp Co. was similar to the present case."

The trial Court below reviewed the Expert case both in the District Court of Chicago and the Court of Appeals for the 7th Circuit and found the Expert case facts similar to the facts in the case at bar. The Court of Appeals below was unable to find any difference over the Expert case and was constrained to register its disagreement.

CONCLUSION.

For the reasons given, therefore, it is respectfully submitted that the judgment of the Court below be reversed and the prayer of petitioners as set forth in the brief be granted.

Respectfully submitted,

MAX R. KRAUS,

ROBERT L. KAHN,

Counsel for Petitioners.

Dated November 28, 1953.

